

## REMARKS

Applicant respectfully requests reconsideration and allowance in view of the foregoing amendments and following remarks. By this response, claims 43, 46, 49, 51, 53 and 58 have been amended to further clarify the invention. After entry of this response, claims 43-54 and 58 will be pending in the application.

In the Office Action, the Examiner objected to the drawings, and objected to and rejected claims 43-54 and 58. Applicant respectfully traverses the rejections.

### *Drawing Objections*

In the Office Action, the Examiner objected to the drawings under 37 C.F.R. §1.83(a) for allegedly not showing a specific feature in the claims, namely, the **varying pore size** feature. Applicant has proposed drawing amendments, shown in the Drawing Change Authorization Request, and corresponding specification amendments to address the Examiner's objection.

Therefore, Applicant respectfully requests approval of the Drawing Change Authorization Request, entry of these amendments and withdrawal of the drawing objection.

### *Claim Objections*

In the Office Action, the Examiner objected to claims 43-54 and 58 because of certain informalities. Specifically, the Examiner correctly noted that in numerous instances, the claims recite a "**slopped**" screen instead of a **--sloped--** screen. Applicant has amended the claims to correct this informality. Applicant has further amended the specification to correct this same informality.

Therefore, Applicant respectfully requests entry of these amendments and withdrawal of the claim objections.

### *103(a) Claim Rejections*

In the Office Action, the Examiner allegedly rejected claims 43-54 and 58 under 35 U.S.C. §103(a) as being unpatentable over the combined teachings of U.S. Patent No. 4,592,275

to Frankl (hereinafter "Frankl") and U.S. Patent No. 2,916,142 to Fontein (hereinafter "Fontein"). However, the Examiner only provided rejection details for independent claims 43, 46 and 49. Therefore, Applicant respectfully traverses the rejections of claims 43, 46 and 49 and reminds the Examiner of the following standards for a proper §103(a) rejection.

A §103(a), or obviousness, rejection is proper only when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time of the invention was made to a person having ordinary skill in the art to which the subject matter pertains." 35 U.S.C. §103(a). The Examiner must make out a *prima facie* case for obviousness. The *en banc* Federal Circuit has held that "structural similarity between claimed and prior art subject matter, proved by combining references or otherwise, where the prior art gives reason or motivation to make the claimed compositions, creates a *prima facie* case of obviousness." *In re Dillon*, 16 U.S.P.Q. 2d 1897, 1901 (CAFC 1990). The underlying inquiries into the validity of an obvious rejection are: "(1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness." *In re Dembiczak*, 175 F.3d 994, 998, (Fed. Cir. 1999).

Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Likewise, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

Additionally, with hindsight, a claim of obviousness can be an easy one to make. Many inventions seem obvious with the clarity of 20-20 hindsight. However, a hindsight basis for obviousness is inappropriate and cannot sustain a *prima facie* case of obviousness. Applicant's respectfully assert that the Examiner is judging obviousness of Applicant's invention using hindsight, and as such, should reconsider the rejections from the proper perspective of the time of Applicant's invention, without the teachings of Applicant's disclosure.

Finally, Applicant respectfully reminds the Examiner of the following: the mere fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness; the proposed modification cannot render the prior art unsatisfactory for its intended use; and the proposed modification cannot change the principle of operation of a reference.

Independent Claims 43, 46 and 49

For the reasons stated below and taking into consideration the standards for obviousness presented above, Applicant asserts that one of ordinary skill in the art would not have considered Applicant's invention obvious at the time of invention and, therefore, that Applicant's rejected claims 43, 46 and 49 are not obvious over the prior art of record.

In both Frankl and Fontein, the separating apparatus consists of elongated slots made by connecting rods or bars at each end that are spaced to create the desired screening width. Note that in these two references, the term "screen" is used generically to illustrate the screening function of the apparatus and not literally to disclose a screen as in the present invention. In fact, per Fontein on col. 10, lines 62-63, "perforated plates ... have been found too thin" for screening purposes. Further, because the rods or bars used in the references are parallel to one another, the slot created between them is of a uniform width and continuous across the width of the device.

In contrast, the present invention discloses a screen to perform the screening function, not rods or bars, and the perforations in Applicant's screen are of a varying width. This varying width optimizes the effectiveness of the invention and would have been impossible to perform using rod and bar created slots, as in the references.

Additionally, in Frankl, the apparatus is designed to be flat so that a sheet can lie over the entire length of the filter bed (see Frankl, col. 4, lines 63-68). The function of the sheet on the filter bed is to make the Frankl device effective, by adding pressure to the liquid separation process. Combining a curved, or sloped, screen to the Frankl device would make the Frankl device unusable for its intended purpose. If the Frankl filter bed were sloped, in a concave manner, away from the sheet, then the sheet would not lie flat on the filter bed (as intended by Frankl) and the inventive effectiveness of the Frankl device would be lost.

In contrast, the present invention discloses a sloped or curved screen, unlike the required flat screen of Frankl. Further, Applicant's invention does not need the extra sheet function as required by the Frankl device to operate effectively.

In view of the above remarks, Applicant requests the withdrawal and reconsideration of the claim rejections for claims 43, 46 and 49. Applicant respectfully submits that independent claims 43, 46 and 49 are in a condition for allowance, and respectfully request such a Notice to that effect.

Dependent Claims 44-45, 47-48 and 50

Dependent claims 44-45, 47-48 and 50 ultimately depend from independent claims 43, 46 and 49, respectively. The allowability of dependent claims 44-45, 47-48 and 50 thus follows from the allowability of independent claims 43, 46 and 49, respectively; as such, dependent claims 44-45, 47-48 and 50 are allowable over the art of record.

Additionally, Applicant contends that, because the Examiner has not distinctly provided support for rejecting dependent claims 44-45, 47-48 and 50, and because that, in fact, the art of record neither discloses nor suggests the subject matter of dependent claims 44-45, 47-48 and 50, these claims are allowable over the art of record.

Therefore, for at least these reasons, Applicant respectfully submits that dependent claims 44-45, 47-48 and 50 are in a condition for allowance, and respectfully request such a Notice to that effect.

Claims 51-54 and 58

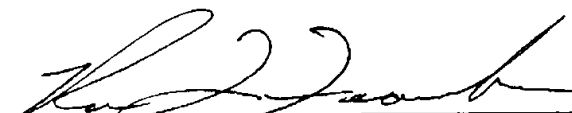
Applicant contends that, because the Examiner has not provided any support for rejecting claims 51-54 and 58, and because that, in fact, the art of record neither discloses nor suggests the subject matter of claims 51-54 and 58, these claims are allowable over the art of record.

Therefore, for at least these reasons, Applicant respectfully submits that claims 51-54 and 58 are in a condition for allowance, and respectfully request such a Notice to that effect.

**Conclusion**

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition of allowance and a Notice to that effect is earnestly solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,  
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